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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,911	01/14/2002	Susumu Hoshi	0216-0463P	9930
2292	7590	05/26/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			SANDERS, KRIELLION ANTIONETTE	
			ART UNIT	PAPER NUMBER

1714

DATE MAILED: 05/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 10/030,911	Applicant(s) HOSHI ET AL.	
	Examiner Kriellion A. Sanders	Art Unit 1714	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

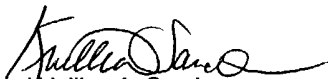
Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-9.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet


 Kriellion A. Sanders
 Primary Examiner
 Art Unit: 1714

Continuation of 10. Other: An explanation of how the amended claims would be rejected is included in the attachment. Also see attached form 892.

Art Unit: 1714

The amendment filed May 11, 2004 has been completely considered, but will not be entered in that:

- ◆ It presents new issues requiring additional consideration and search
- ◆ It does not place the application in condition for allowance
- ◆ It does not simplify the issues for appeal.

1. The amendment filed under Rule *116 presents new issues requiring additional consideration and search*. In both the initial and final rejections, claims 1-9 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant's claims as originally presented could not be thoroughly examined, because it was not clear by the claim language, what applicant considered the invention to be. The claims were rejected for the following reasons:

1. The claims are indefinite in their definition of the B polymer block. Applicant initially defines the B polymer block as being a component selected from polymer blocks (a), (b), and (c) as set forth in claim 1. Applicant then further defines the claimed block polymer as having one or more B polymer blocks consisting of (B-1) through (B-5). Since polymer blocks (a), (b), and (c) differ substantially from polymer blocks (B-1) through (B-5), it is not clear what applicant considers the invention to be.

Applicant's proposed amendment filed May 11, 2004 does now serve to clarify that that which applicant considers the invention to be and serves to address the issues raised in the rejection under 35 USC 112 second paragraph. However, the amendment was not presented in a

Art Unit: 1714

timely manner. There is no reason why the amendment filed on May 11, 2004 was not presented earlier, prior to final rejection. **Therefor, if the amendment were to be entered it would necessitate a new search and further consideration** because it is immediately clear from the newly presented amended claims that the invention is subject to rejection at least under 35 USC 103 over Hoshi et al., US Patent 6,235,847.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. If entered, claims 1-9 would be rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshi et al, US Patent 6,235,847.

Hoshi et al discloses a linear block copolymer comprising at least two S polymer blocks in combination with at least two B polymer blocks. Polymer block S is a monovinyl aromatic compound such as styrene or vinyl toluene and is present in an amount of 60-95% by weight of the block polymer. Polymer block B is a conjugated diene such as butadiene or isoprene or a combination of such dienes. The total amount of vinyl aromatic hydrocarbon blocks and conjugated diene polymer units in the linear block polymer ranges from 65-95% by weight and 35-10% by weight, respectively. The linear block copolymer may be admixed with an additional styrene resin as well as hindered phenolic stabilizers. See col. 3, line 57 through col. 4, line 45; col. 8, lines 46-59; col. 11, lines 7-28. See Example 1 wherein 2-[1-(2-hydroxy-3,5-di-t-pentylphenyl)ethyl]-4,6-di-t-pentylphenyl acrylate is disclosed as a suitable phenolic stabilizer. Hoshi et al does not place criticality on the weight percentage of the vinyl

Art Unit: 1714

aromatic hydrocarbon in the B polymer blocks, but since neither Hoshi or applicant require a vinyl aromatic hydrocarbon in the B polymer blocks, this limitation of applicant's claims is met by Hoshi et al. Hoshi et al does not indicate the short segment ratio of the vinyl aromatic monomer unit in the block copolymer, but since applicant indicates that this ratio may be 0% this ratio is met by Hoshi et al as well. Hoshi is silent as to the unit weight ratios of isoprene to butadiene, but in view of the range of the weight ratio of isoprene to butadiene set forth in applicant's claims, formulation of a copolymer having, for example, B blocks with 50 weight % isoprene and 50 weight% butadiene would have been obvious in view of Hoshi et al., since the patent discloses that the B blocks may be comprised of a combination of isoprene and butadiene.

Therefor applicant's suggested amended claims as proposed in the amendment filed May 11, 2004, would be found obvious over Hoshi et al.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. If entered, claims 1, 4, 8 and 9 would be rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No.

Art Unit: 1714

6,235,847. Although the conflicting claims are not identical, they are not patentably distinct from each other because of reasons outlined in the above rejection under 35 USC 103.

Entry of the amendment filed May 11, 2004 **would not place the application in condition for allowance**. This is evident in that the claims would be rejected under 35 USC 103 over Hoshi et al.

Entry of the amendment filed May 11, 2004 **would not simplify the issues for appeal**. Entry of the amendment would create new prosecution of issues that could have been resolved prior to final rejection had the amendment been entered prior to final rejection.

Should applicant desire to have an amendment entered at this time, he should obtain an extension of time, and/or file a notice of appeal, and/or file an RCE application. An amendment presented at this time should place the application in condition for allowance not only over Hoshi et al, but over any other prior art that may be pertinent to the examination of this application, since the application is currently under final rejection.

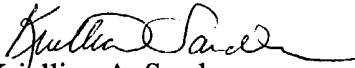
Applicant is advised that a certified copy of the foreign priority documents have not been received by the PTO.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kriellion A. Sanders whose telephone number is 571-272-1122. The examiner can normally be reached on Monday through Thursday 6:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kriellion A. Sanders
Primary Examiner
Art Unit 1714

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